

II. REMARKS

Remarks

The Examiner presents a miscellaneous rejection stating:

"The relationship of claims 32-48, which are stated as being "previously presented" and the claims acted on in previous actions as well as the Board of Appeals decisions, is not clear. It is requested that applicant clarify the relationship."

This rejection is not understood inasmuch as 37 CFR 1.421 (c) allows "previously presented" to be used.

Clarification is requested.

The Examiner next rejects claims 21, 22, 27, 28 - 30, 31, and 58 under 35 USC 112, second paragraph, as being indefinite.

It is believed the amendments presented above render these rejections moot.

Claims 5, 8, 17-24 and 27-58 are next rejected under 35 U.S.C. 112, second paragraph as being indefinite.

It is believed the amendments presented above render these rejections moot.

Claims 5, 17, 21, 22, 31, 34, 35, 37, 39, 40, 42 - 51, 55 and 58 are next rejected under 35 U.S.C. 102 (b) as

being anticipated by the patent to Kirkland (6,006,945).

35 U.S.C. 102 (b) states:

" (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date application for patent in the United States."

Applicant's filing date is February 18, 1997.

Kirkland's patent issued on December 28, 1999, more than two years after applicant's filing date. The Examiner has provided no date prior to applicant's filing date for any publication, use, or sale of the item described in Kirkland's teachings. Therefore, the rejection issued under 102 (b) is not believed well founded.

Next, the Examiner continues:

"The patent to Kirkland discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see column 4, line 23 et seq and the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include balls,

clothing, cleaning items and personal hygiene products (see column 5, line 44 et seq). The step of folding the article is inherent in the Kirkland process and is read on the step of reducing a piece of clothing to the size of the package.

"Regarding claims 21 and 22, articles like clothing comprise one or two flaps form openings, e.g. sleeves or hosiery.

"Regarding claims 35, 40, 42 and 51, Kirkland discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

"Regarding claims 45, 46, and 48, the claimed lips are read on the edge portions of the seperable parts of the package of Kirkland.

"Regarding claim 58, Kirkland discloses the article being a first aid item."

This rejection is traversed.

The Examiner is directed to applicant's specification, wherein it is expressly stated that he knows various forms of can packaging exist, that he considers them generic, rather than iconic, and he does not want to use a generic icon for his package but rather one that can easily identify with an activity. What is a generic can identifiable with?

Nothing.

The only reason Kirklands package is in the form of a can is so it can dispense non-soda items from a soda machine. There is no thematic icon disclosed. Kirkland's can configuration serves a utilitarian purpose only. There are no method steps disclosed, except those the Examiner has conjectured to exist, as the patent is directed to an article of manufacture, not a method.

The rejection fails as it is in direct opposition to what applicant wants and teaches, and does not even pertain to a method. Here the Examiner is directed to the decision rendered in. Sound-scriber Corp. V. U. S. , 360 F. 2d 954, 960, 148 USPQ 298, 301 (Ct. Cl. 1966):

" The opinion says anticipation may be shown by less than "complete anticipation" if one of ordinary skill may in reliance on the prior art "complete the work required for the invention", and that "it is sufficient for an anticipation" if the general aspects are the same and the differences in minor matters is only such as would suggest itself to one of ordinary skill in the art. Those statements relate to obviousness, not anticipation. Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as

in the claim. A prior art disclosure that "almost" meets that standard may render the claim invalid under 103; it does not "anticipate".

Claims 27/5 - 29/5, 30, 38, and 41 are rejected next under 35 U.S.C. 103 (a) as being unpatentable over the patent to Kirkland (6,006,945). The Examiner states:

"Since Kirkland teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kirkland, including articles with openable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention."

The rejection is traversed.

First, reiterating, Applicant's filing date is February 18, 1997.

Kirkland issued on December 28, 1999, more than two years after applicant's filing date.

Inasmuch as it is not believed there was any publication use or sale of Kirkland prior to filing by

Applicant, this reference is again not believed to be prior art under 103 (a).

Again, the Examiner is directed to applicant's specification, wherein it is expressly stated that he knows various forms of can packaging exist, that he considers them generic, rather than iconic, and he does not want to use generic icon for his package but rather one that can easily identify with an activity. What is a generic can identifiable with? Nothing.

The only reason Kirklands package is in the form of a can is so it can dispense non-soda items from a soda machine. There is no thematic icon disclosed. His configuration serves only a utilitarian function. Further, applicant's method steps are nowhere found, either explicitly recited, or inherently.

The rejection fails as it is in direct opposition to what applicant wants and teaches and actually teaches away therefrom. Here the Examiner is directed to the decision in Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent is irrelevant in determining obviousness under Section 103."

Secondly, the Examiner seems, again, in this rejection to overlook, or ignore, the fact that applicant's claims are directed to a method wherein thematic packaging in which items relative to the activity to which the package is thematic are located. The rejection is completely devoid of logic and fails. In re Wright, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988):

"[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves."

Claims 5, 17, 18, 21, 22, 31, 34, 35, 37, 39, 40, 42 - 51 and 55 are next rejected under 35 U.S.C. 102 (b) as being anticipated by the patent to Kaufman (5,813,538).

The Examiner states :

" The patent to Kaufman discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include t-shirts, towels etc (see

column 1, line 17 et seq) . The step of folding the article is inherent in the Kaufman process and is read on the step of reducing a piece of clothing to the size of the package.

" Regarding claim 18, Kaufman discloses in column 5, line 43 et seq that combining of two packages in one outer package.

" Regarding claims 21 and 22, articles like clothing comprise one or two flaps that form openings, e.g. sleeves.

" Regarding claims 35, 40, 42, and 51 and their dependent claims, Kaufman discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

" Regarding claims 45, 46, and 48, the claimed lips are read on the edge portions of the separable parts of the package of Kaufman. "

This rejection is traversed .

Kaufman teaches promotional packages including a fabric article, compressed under substantial pressure, into a shape of a container of an item to be promoted; i.e., a shirt highly compressed into a cylinder which would fit into the cylindrical portion of a soda bottle, into an area below a shoulder and neck of a bottle, having a brand label thereon

for use in promotion of the actual item. Nowhere are steps of a method found, as claimed by applicant.

There is no thematic icon presented here, and applicant does not find any folding, (see figure 1 of Kaufman) much less anything else which could be construed as presenting an icon package suggestive of an activity within which the non-conforming article of applicant can be found.

Kaufman actually teaches away by compressing his non folded article into a shape which conforms to his promotional package shape, identical to the package of the true item.

Nothing is found, when viewing Kaufman without the benefit of applicant's teaching, to even logically suggest applicant's teaching. Here see: Hybritech Inc., v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986):

"Focusing on the obviousness of substitutions and differences instead of on the invention as a whole... was a legally improper way to simplify the difficult determination of obviousness."

and LINCOLN STORES, INC., v. NASHUA MANUFACTURING COMPANY, 157 F.2d 154, 70 USPQ 254 (CA 1 1946)

(1) "Earlier disclosures do not anticipate where they afford

no more than starting point and do not teach how to practice new invention."

(2) "Patent does not anticipate where it failed to solve problem which subsequent patent solves successfully."

(3) "Previous adoption of essential element of patent for another and distinct purpose is not anticipation."

And Pfizer Inc. v. International Rectifier Corp., 545 F.Supp. 486, 207 USPQ 397 (C.D. Calif. 1980) 685 f.2d 357 (9th Cir. 1982)

"A prior art publication cannot be modified by the knowledge of those skilled in the art for purposes of anticipation....The information conveyed by prior art is crystallized as of the date it is made public and the crystals cannot be corrected or altered to convey information or facts later acquired by others skilled in the art."

There is no solid evidentiary base to this rejection and it fails.

Claims 19 - 20, 23 27/5 - 29/5, 30, 38, 41, and 58 are next rejected under 35 U.S.C. 103 (a) as being unpatentable over the patent to Kaufman (5, 813, 538). " The Examiner states :

" Regarding claims 19, 20, and 23, combining of two packages containing different articles in one outer package is well known in the art and the Examiner takes Official notice that it is well known in the packaging art. Packing two different articles are well known in kit form to provide the consumer with one pack. Similarly, the use of means for attaching a package to another article (claim 23) is well known in the art and Official notice is taken and it would have been obvious to one skilled in the art to provide such means to the packages of Kaufman.

" Regarding the other claims, Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kaufman, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. "

The rejection is traversed.

Again, Kaufman teaches a promotional package having an

article therein which is highly compressed into conformity with limitations of the package interior, the package having a shape identical to the shape of the package for the item being promoted and having a label thereon identifying what is being promoted.

Again, without the benefit applicant's teaching, it is a very far stretch of all the machinations that would need to transpire to come up with applicant's teachings, all based on a thematic package of an icon associated with an activity, to which the content of his package is relevant.

What does a shirt in a labeled promo coffee can have to do with anything but advertising and promotion of the particular brand of coffee? Nothing. There is once again, no method disclosed in the cited art, but only an article of manufacture which exactly emulates the article it is meant to advertise. There is no suggestive feature directed to an activity associated with a thematic icon recognized as associated to the activity.

The rejection fails on logical application.

Claims 8 - 15, 24 - 26, 27/8 +, 28/8 +, 29/8 +, 36 and 52 - 57 are next rejected under 35 U.S.C. 103 (a) as being unpatentable over the patent to Kaufman (5, 813, 538) in view of Gossard (3, 624, 939). The Examiner states:

"The patent to Kaufman shows various embodiments and shapes of packages having separable parts but it doesn't show package shaped as balls. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball and soccer ball. It would have been obvious to one skilled in the art to shape the packages of Kaufman in any desired shape including balls shown by Gossard. The modification of Kaufman by forming the package with a ball shape as shown by Gossard would have been obvious because the use of one known and equivalent package shape for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. Since Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package."

This rejection is traversed.

Inapplicability of Kaufman without the benefit of the applicant's teaching at hand, as argued above, is reiterated here first.

Gossard teaches a novelty container for photographs which is a hinged two piece structure, in the shape to identify a particular sport and has structure in the

interior thereof for storing photographs therein in a particular orientation relative to the hinge.

When viewing the teaching as a whole, as required by law, the combination proposed by the Examiner, which defeats the individual purpose of each patent, is incomprehensible.

What exactly does one have, a novelty container with a compressed piece of cloth therein, or a coffee can with picture holders therein? The logic for such proposed combination escapes applicant, as, again, no method utilizing thematic package containing an article for used in the activity themed is found. The rejection fails.

Claims 32 - 35, 40, 42, and 51 are next rejected under 35 U.S.C. 102 (b) as being anticipated by the patent to Forrest (1, 800, 990) or Francis (D346185). The Examiner states:

" Each of these patents discloses a method for making a combination of a package and article that comprises constructing a package as a replica of a recognizable icon having a shape that is different from the article to be placed in it with the package shape conveying information relative a sport, the and locating an article within the package. Both packages and articles are used in environments which the shape of the package indicates."

The rejection is traversed.

Forrest discloses a baseball shaped container for edibles, which can be " pitched " to a customer, with his change in a slotted pocket. The baseball container is formed with a plurality of sections pasted together by cover sections placed thereover.

Francis teaches a football card holder which has planar sides, top and bottom, and resembles a cross section of a football on its top. Again, there is no method for use of a thematic package found having an article therein which is useful in the activity to which the theme of the package is iconic.

Further, the logic of the combination proposed by the Examiner escapes applicant, since his claimed method is nowhere found in these patents, directed to structures.

Claims 32-35,37,40,42,51, and 55 are next rejected under 35 U.S.C. 102 (b) as being anticipated by the patent to Servick (5,450,779). The Examiner states:

"Each of these patents discloses a method for making a combination of a package and article that comprises constructing a package having the shape of a football and which is different from the article to be placed in it, the package comprises of totally separable parts (see the

figures). Examples of articles that can be placed in the package include toys, wallet, keys, coins, candy bars, chips etc (see column 3, line 23 et seq).

" Regarding claims 35,40,42,51 and 51 and their dependent claims, Servick discloses the method of using more than one combination of a package and articles since the patent discloses the packing of different articles in the different packages ."

The rejection is traversed.

The Examiner's beginning statement the each of these patents discloses a method ... is not at all well taken. Not one patent cited against the claims anywhere in this entire action has anything to do with a method. All are directed to structures.

Again here, a structure in the form of a football shaped throwing toy, which may serve a secondary purpose of a container for something or other, does not disclose applicant's method.

There is no mention of placing anything of utility relative to football, within the toy, and there is no mention of marketing the combination, as relative to football.

Clearly, this rejection fails.

Claims 26, 38,42,54,56 and 58 are next rejected under

35 U.S.C. 103 (a) as being unpatentable over the patent to Servick (5,450,979). The Examiner states:

"The package of Servick lacks the specific article recited in claim 26. Since Servick teaches the placing of different kinds of articles within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Servick, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention."

The rejection is traversed.

Servick, again discloses a toy, with some secondary use. As such the item is inherently directed toward children, not say, to an avid adult football fan. Placement of rain gear within the toy, having a hollow which is insulated for receipt of a pop can or the like, is a leap of imagination on the part of the Examiner. Further, once again, an article, not a method, is disclosed. The art is thus rendered inapplicable and the rejection fails. Here

see Ex parte Levengood, 1993 WL 418326, 28 U.S.P.Q.2d 1300, 1301 (B.P.A.I. 1993):

"Motivation for combining teachings of various references need not be explicitly found in the references themselves. The Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. However, an Examiner's mere assertion that one of ordinary skill in the relevant art would have been able to arrive at a claimed invention because he had the necessary skills to carry out the requisite process steps is an inappropriate standard for obviousness."

Claims 24, 25, 36, 52, 53, and 57 are next rejected under 35 U.S.C. 103 (a) as being unpatentable over the patent to Servick (5,450,979) in view of Gossard. The Examiner states:

"The package of Servick lacks the shape of a golf ball. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball, and soccer ball. It would have been obvious to one skilled in the art to shape the package of Servick in any desired shape including balls as shown by Gossard would have been obvious because the use of one known and equivalent package shape for

another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. Regarding claim 18, Kaufman discloses in column 5, line 43 et seq that combining of two packages in one outer package."

The rejection is traversed.

Inapplicability of Servick's structure to applicant's method, set forth above, is reiterated here.

Inapplicability of Gossard's structure to applicant's method, set forth above, is reiterated here.

Summarily, the combination of an insulating toy with an other ball shape still provides an insulating toy ---- not applicants method of creating thematic package, creating an article for use in the themed activity, placing the article in the package and marketing same. This rejection is also deemed overcome.

The Examiner's opinion that a step is disclosed here and there is not well founded. In this regard, the Examiner is directed to Ex parte Schwenk, Bloch, and Whitman, 1947 WL 3310, 73 USPQ 85 (BdPatApp&Int 1947):

"Anticipation of individual steps is insufficient to anticipate combination of steps required to produce new result not contemplated by prior art."

and see In re Bell, 991 F.2d 781, 785, 26 USPQ 2d 1529 (Fed. Cir. 1993):

"...the PTO asserted a rejection based upon the combination of a primary reference disclosing a protein (and its complete amino acid sequence) with a secondary reference describing a general method of gene cloning. We reversed the rejection, holding in part that "[t]he PTO's focus on Bell'[s] method is misplaced. Bell does not claim a method. Bell claims compositions, and the issue is the obviousness of the claimed compositions, not of the method by which they are made."

In likewise manner, the articles claimed in the prior art should not make the method disclosed and claimed by applicant, obvious. Here see Ex parte Clapp, 1985 WL 71951, 227 USPQ 972 (B.P.A.I. 1985)

"Presuming arguendo that the references show the elements or concepts urged, the Examiner presented no line of reasoning as to why the artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite

references to show that one or more elements or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of element. That is to say, the appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The Board found nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the Examiner. Additionally, the Board found no line of reasoning in the answer as to why the artisan would have found the modifications urged by the Examiner to have been obvious. Based upon the record, the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide."

If the Examiner continues these lines of rejection, all

apparently based on conjecture and opinion, rather than fact, applicant demands Affidavits supporting these rejections, from the Examiner.

As a conclusion, when all the cited art is viewed individually, or in combination, without the benefit of applicant's disclosure at hand, there is absolutely nothing found in any of the art to persuade one skilled in the art to create applicant's method, nor his package, nor his article. Clearly, the cited art has nothing in it to mobilize one to create what applicant discloses and claims. It is merely, with applicant's disclosure available as a blueprint, that hindsight reconstruction, taking bits and pieces from the art, and molding such bits and pieces into a shape that fits applicant's mold, after much machination in changing teachings of articles of manufacture into teachings of a method, as claimed by applicant. Here the Examiner is directed to the decision in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985):

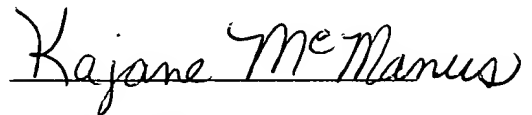
"It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a "blueprint." When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination

other than the hindsight obtained from the invention itself. It is critical to understand the particular results achieved by the new combination."

An earnest endeavor has been made to place the application in condition for allowance and an early action to that end is awaited.

Respectfully submitted,

Date: March 31, 2008

A handwritten signature in cursive script that reads "Kajane McManus". The signature is written in dark ink and is positioned above a horizontal line.

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